

Applicants request that these claims be canceled without prejudice. However, Applicants believe that claims 20-22 and 44-46 may be allowed relatively quickly given the recent changes in the patent laws. Applicants address each basis for rejecting the remaining pending claims below.

I. Rejection of claims under 35 U.S.C. §101

The Examiner provisionally rejected pending claims 20-22 and 44 because they claim the same invention as claims 20-22 and 46 in pending application 09/470,651. Applicants further note that current claims 45 and 46 contain the same language as claims 47 and 48 in the pending parent application, Ser. No. 09/046,835. Further, all of the present claims 20-22 and 44-46 contain the same language as claims 20-22 and 44-46 in related application Ser. No. 09/470,650. Applicants will address this rejection when claims issue in any of these applications.

II. Rejection of claims under 35 U.S.C. §103

The Examiner rejected claims 20-22 and 44-45 as being obvious in light of a combination of references including U.S. Patent 5,904,799 by Donohoe and assigned to Micron Technology, Inc. Section 103(c), however, has recently been amended by Congress to state the following.

Subject matter developed by another person, which qualifies as prior art only under . . . subsection[] (e) . . . of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Section 102(e), in turn, addresses prior art in the form of a “patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent.” Further, the change in section 103 applies to any application

filed on or after May 29, 2000. (*See* section 4807(b) of the American Inventors Protection Act of 1999.)

The Donohoe reference was filed before but issued after Applicants filed the current application. (Donohoe's priority date is April 16, 1993, the current application enjoys a priority date of June 2, 1995, and Donohoe did not issue until May 18, 1999.) Thus, Donohoe qualifies as prior art only under subsection 102(e). Further, both the subject matter in Donohoe and the current claimed invention were, at the time the invention was made, assigned to Micron Technology, Inc. Finally, claims 20-22 and 44-45 are being presented as part of a Continued Prosecution Application (CPA) filed on or after May 29, 2000 (the CPA was filed in September of the year 2000). As a result, this application benefits from the new §103 provision. Accordingly, The Donohoe reference can no longer be cited against claims 20-22 and 44-45 as part of an obviousness rejection. Because (1) the cited combinations against these claims are now untenable, and (2) Applicants have amended claim 20 to independent form, Applicants request that the Examiner withdraw the rejection and allow these claims.

As for claim 46, that Examiner indicated that the combination of Fujita (U.S. Pat. No. 5,084,413), Numata (U.S. Pat. No. 4,759,958), and an IBM disclosure rendered that claim obvious without having to include Donohoe in the combination. However, Applicants note that claim 46 is dependent upon claims 44 and 45. In rejecting those claims, the Examiner admitted that the Fujita/Numata/IBM combination was an insufficient basis. As a result, the Examiner had to resort to a combination of Fujita, Numata, IBM, Donohoe, and yet another reference (U.S. Pat. No. 5,354,715 by Wang). Because claim 46 is dependent upon and even narrower in scope than claims 44 and 45, Applicants contend that (1) the Fujita/Numata/IBM combination alone is an insufficient basis for rejection; and (2) Donohoe must be included in rejecting claim 46. However, for the reasons presented above, combinations including the Donohoe reference can no longer serve as a basis for rejecting claims in this recently-filed CPA.

CONCLUSION

In light of the above amendments and remarks, Applicants submit that claims 20-22 and 44-46 are allowable over the applied references. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact Applicants' undersigned attorney at the number indicated.

Respectfully submitted,

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